

Application No.09/254,058

Attorney Docket: 2016-11

**REMARKS**RECEIVED  
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Claims 1-5, 16-31, 34 and 36-50 were not entered. Applicant has canceled all the pending claims 6-15, 32-33, 35 and 51. Claims 52-62 are newly added. Applicant respectfully request reconsideration of the application in light of the following remarks.

**CLAIM REJECTION UNDER 35 U.S.C. §101**

Claim 51 was rejection by the Examiner under 35 U.S.C. §101 because the claimed invention lacks patentable utility. Applicant has canceled claim 51 and the new claims excludes the canceled claim 51. Applicant believes claim rejection under 35 U.S.C. §101 is moot, accordingly.

**CLAIM REJECTION UNDER 35 U.S.C. §112**

Claim 35 was rejected by the Examiner under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has canceled claim 35 excluding its incorporation into any of the new claims. Applicant believes claim rejection under 35 U.S.C. §112 is moot.

**CLAIM REJECTION UNDER 35 U.S.C. §103**

Claims 6-15, 32-33, 35 and 51 were rejected under 35 U.S.C. §103 as being unpatentable over USP 5,782,692 to Stelovsky (hereinafter "Stelovsky"). The pending claims were incorporated and narrowed to the new claims 52-62 within the scope of the original disclosure. Applicant respectfully submits:

Stelovsky does not teach, suggest, or describe an input means for identifying selected pre-recorded language learning data which a user desired to obtain from an internet-based communication network, said language learning data including audio data and caption data; an interface means responsive to said input means for receiving the identified language learning data from the internet-based communication network.

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In this claim amendment, applicant has limited the language learning terminal in claims to "foreign language learning terminal" and further limited the function of the controller means to "synchronously output the caption data component and the audio data components to a display". Applicant respectfully further submits:

Stelovsky does not teach, suggest, or describe a foreign language learning terminal having a controller means for synchronously outputting the caption data component and the audio data component to a display.

Applicant notes that "caption data" and "audio data" are two crucial elements in *foreign language* learning. Listening "audio data" is to improve the user's conversational skill in foreign language because no listening comprehension means no conversational talk. "Caption data" is not separable from "audio data" in foreign language learning especially to people living in non-alphabet world like South Korea and Japan. For example, to most Japanese and Korean adult people the most difficult part in English language learning is to listen and understand although they know how to read and understand by book-based education. Thus, separating and/or synchronizing "caption data" and "audio data" has to be one of the key features in foreign language learning system if it is to be marketed in non-alphabet world. Applicant respectfully points out that Stelovsky does not teach, suggest, or describe a foreign language learning terminal in application of internet at the time the invention was made.

#### PRIMA FACIE OBVIOUSNESS

To establish a *prima facie case* of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time the invention was made, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. 2142.

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A. PREDICTABILITY AT THE TIME THE INVENTION WAS MADE

Applicant respectfully notes that this application was filed under 35 U.S.C. §371 claiming priority of International Application No. PCT/KR98/00202 filed *July 10, 1998*, which further claims priority of Korean Patent Application Nos. 1997/32037 and 1997/53174, filed *July 10, 1997* and *October 16, 1997*, respectively.

Applicant further notes that the invention was made in the early months of 1997 when the word “network” existed to mean a company network to operate an intranet software like Management Information System (MIS). At least a person having ordinary skill in the art at the time when the invention was made would regard the word “network” synonymous to “company network” or “local area network”; whereas “internet” synonymous to “beyond-the-company communication tool” which is not accessible from the “company network”. Further, when it comes to foreign language learning in the year 1997 when the invention was made a language learning system using “network” meant nothing more than using “sharing headphones” in the language laboratory. Applicant respectfully traverses the Examiner’s position interpreting that in the year 1997 the selection of “network” or “internet” would be a design choice.

Applicant respectfully notes that applying “internet communication system” to foreign language learning in the year 1997 when the invention was made needs to be interpreted as “secondary considerations” in *Graham v. John Deere* which was quoted by the Examiner in the obviousness rejection. The court in *Graham v. John Deere* quoted by the Examiner teaches “secondary considerations” as follows:

Such secondary considerations as *commercial success*, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the *circumstances surrounding the origin of the subject mater sought to be patented*. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

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Applicant respectfully points out market differences in “network” language learning under a conventional language learning system and “internet-based” foreign language learning under this invention in the year 1997. In the atmosphere where foreign language learning and its applications are limited to cassette tape players, prevalent floppy disks were useless tools in foreign language learning due to storage limitation for recording sound therein. Applicant respectfully submits that “internet-based” foreign language learning system is not anticipated by “company network” concept at the time when the invention was made.

#### B. OVERLAP OF RANGES

*A prima facie case obviousness exists in the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art. M.P.E.P 2144.05.*

Applicant respectfully contends that *the “internet-based communication network” in the application does not overlap or lie inside “network” of Stelovsky in the year 1997 when the invention was made.* The difference of wired telephone and wireless telephone may be compared to categorizing “local area network” of Stelovsky and “internet-based network” in the application.

Applicant respectfully notes that this invention was made in the year 1997 during the era of *Windows 95* that continued up until mid 1998 when *Windows 98* was released. Applicant respectfully submits that “network” in the year 1997 when the invention was made was prevalently known to the person skilled in the computer as “local area network” enabling “company automation”.

#### NEW CLAIMS 52-62

Considering years long file history and complication of previous actions and amendments, all the previous claims were canceled and rewritten in new consecutive claims 52-62 narrowed within disclosure of the previous claims and specification, where claims 52 and 61 are independent.

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Claim 52

This is narrowed from the canceled independent claim 6. The preamble has been limited from "language learning terminal" to "*foreign* language learning terminal". The controller means has been limited to "synchronously output the caption and audio data components to a display". The "input means" is limited to "an input means for identifying selected pre-recorded language learning data which a user desired to obtain from an *internet-based communication network*, said language learning data including audio data and caption data". The "interface means" is also limited to "an interface means responsive to said input means for receiving the identified language learning data from the internet-based communication network". Claims 53-60 are depended from claim 52. No new matters are added.

Claim 61

Applicant has narrowed the canceled claim 32 to second independent claim 61 in this amendment. The preamble has been limited from "caption-based language learning terminal" to "caption-based *foreign* language learning terminal". Applicant has limited "input means" to "an input means for identifying selected pre-recorded language learning data which a user desired to obtain from an internet-based communication network, said language learning data including audio data and caption data". Applicant has further limited "communication interface" to "a communication interface means responsive to said input means for receiving the identified language learning data through the internet-based communication network". Claim 62 is depended from claim 61. No new matters are added.

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**CONCLUSION**

In view of the amendments and remarks made above, it is respectfully submitted that claims 52-62 are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectively submitted,

Date: November 20, 2006

  
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